

Remarks

Applicants have cancelled claims 1-11, 14-16, and 21 without prejudice or disclaimer. New claims 23-42 have been added in order to claim additional embodiments of the subject matter of the provisionally-elected group. New claims 23-42 find support throughout the specification and claims as originally filed, and thus no new matter has been added.

Original claims 12-13, 17-20, and 22, and new claims 23-42, are pending.

The Restriction Requirement

Pursuant to Paper No. 3, mailed March 25, 2003, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups 1-56. The Examiner contends that the inventions are distinct, each from the other.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of Group 2, directed to, *inter alia*, polynucleotides encoding SEQ ID NO:10, including but not limited to SEQ ID NO:3, represented by original claims 1-10 and 14-15 (now cancelled), and new claims 23-42. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 1-11, 14-16, and 21 have been cancelled without prejudice or disclaimer, and that new claims 23-42 are directed to subject matter falling within the ambit of Group 2 as cast by the Examiner. Applicants also note that while the Examiner has characterized Group 2 as directed to polynucleotides of SEQ ID NO:3, such polynucleotides are species of the broader originally-claimed genus of polynucleotides encoding polypeptides of SEQ ID NO:10. *See* claims 1(b)-(c) and 2-3.

With respect to the Examiner's restriction of groups directed to a particular nucleic acid sequence, polypeptides encoded thereby, antibodies recognizing such polypeptides, and methods of using the same (*e.g.*, Groups 2, 9, 16, 23, 30, 37, 44, and 51), Applicants traverse. As the Examiner has implicitly recognized, even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups 1-56 are separately classified, Applicants nonetheless submit that, with respect to a

given sequence, a search of the claims of the groups directed to that sequence would also provide useful information for the claims of the other groups directed to that sequence. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. Thus, since the searches for proteins, nucleic acids encoding such proteins, antibodies to such proteins, and methods of making and using the same commonly overlap, Applicants respectfully submit that the Examiner's assertion that the combined search and examination of such compositions and methods using the same would entail a serious burden as to a particular sequence has been rebutted, even assuming *arguendo* that all of the searches were not coextensive.

Further, with respect to the Examiner's restriction of groups directed to different nucleic acid sequences (*e g.*, Groups 1-7), which are not separately classified, Applicants also traverse. In particular, Applicants note that the Examiner has not addressed M.P.E.P. § 803.04. Pursuant to the notice *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996), § 803.04 states that even when nucleotide sequences encoding different proteins are contained in an application, a reasonable number, normally ten sequences, will be examined in a single application. Accordingly, a reasonable number of the instant sequences should be examined together, and the Examiner has not indicated why seven sequences are unreasonable in the present case. Thus, Applicants respectfully submit that the present requirement for election should be withdrawn.

Accordingly, in view of M.P.E.P. §§ 803 and 803.04, claims directed to polynucleotides encoding SEQ ID NOS:2-8, the polypeptides encoded thereby, antibodies recognizing such polypeptides, and methods of using the same should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Further, although not acquiescing to the restriction requirement, Applicants nevertheless note the claims of Group 2 and the claims of Groups 30 and 51 are related as between a product and processes for making or using the product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), if an elected product claim is found allowable, "withdrawn process claims which depend

from or otherwise include all of the limitations of the allowable product claim will be rejoined." M.P.E.P. § 821.04. Accordingly, Applicants respectfully request that if any of the claims of Group 2, i.e., new claims 23-42, are found allowable, then the process claims of Groups 30 and 51 be rejoined and examined for patentability.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

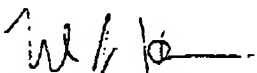
Conclusion

Entry of the above amendment is respectfully solicited. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated: April 24, 2003


Mark J. Hyman
Attorney for Applicants

Reg. No. 46,789

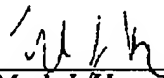
Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
Telephone: (240) 314-1224

KKH/MJH/ba

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. § 1.8

1. Fax Cover
2. Fee Transmittal Sheet
3. Provisional Election Under 37 C.F.R. § 1.143 With Traverse And
Amendment Under 37 C.F.R. § 1.115

I hereby certify that the above-listed correspondence is being facsimile transmitted to the
United States Patent and Trademark Office on April 24, 2003.



Mark J. Hyman (Reg. No. 46,789)
Attorney for Applicants

Human Genome Sciences, Inc.
9410 Key West Avenue
Rockville, MD 20850
Telephone: (240) 314-1224